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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL WALLER and MATTHEW A. WARD

Appeal 2008-1127
Application 09/804,171
Technology Center 2600

Decided: July 29, 2008

Before: ANITA PELLMAN GROSS, ROBERT E. NAPPI, and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a rejection of claims 1-13 and 15-42. No other claims are pending (Br. 2). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

We affirm.

According to Appellants, the invention relates to automatically providing and displaying new information to a mobile device as the orientation and location of the device changes. (*See* Spec. 7)

An understanding of the invention can be gleaned from exemplary claim 1, which is reproduced below:

1. A method of accessing information on an information network accessible by a mobile communications device, the method comprising:

determining a location of the device;

determining an orientation of the device;

supplying visual information to a user appropriate to the location and orientation of the device from a collection of information stored on the information network, various elements of the collection of information being associated with specific locations;

monitoring the location of the device as the location of the device changes;

and automatically retrieving and displaying new visual information to the user as the location and orientation of the device change so that new elements of the collection of information associated with locations in proximity to the location of the device are supplied to the user as the location and orientation of the device change.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tsuda	US 6,233,094 B1	May 15, 2001
Hashimoto	US 6,338,020 B2	Jan. 8, 2002
Chern	US 6,381,465 B1	Apr. 30, 2002

Kikinis	US 6,389,290 B1	May 14, 2002
Yurkovic	US 6,668,353 B1	Dec. 23, 2003

Claims 1, 2, 5, 7-9, 11-13, 15-28, 31, and 33-42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chern, Yurkovic, and Tsuda.

Claims 3, 4, 10, 29, and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the collective teachings of Chern, Yurkovic, Tsuda, and Kikinis.

Claims 6 and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the collective teachings of Chern, Yurkovic, Tsuda, Kikinis, and Hashimoto.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief (received April 10, 2006) and the Answer (mailed July 18, 2007) for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Appellants' arguments are directed to claims 1-13 and 15-42 as a group. (*See* Br. 4-5). Accordingly, we select claim 1 as representative of the group of claims 1, 2, 5, 7-9, 11-13, 15-28, 31, and 33-42. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a

rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.*

Under this framework, once an Examiner demonstrates that the elements are known in the prior art and that one of ordinary skill could. combine the elements as claimed by known methods and would recognize that the capabilities or functions of the combination are predictable, then the Examiner has made a prima facie case that the claimed subject matter is likely to be obvious. The burden then shifts to the Appellants to show that the Examiner erred in these findings or to provide other evidence to show that the claimed subject matter would have been nonobvious.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*. 127 S. Ct. at 1741 (citing *In re Kahn*, 441 F.3d at 988).

ANALYSIS

The dispute focuses on Appellants' argument "that Tsuda does not teach determining an orientation of a device and providing information in accordance with that orientation." (Br. 5). The first part of the dispute relates to the step of "determining an orientation of a device" as set forth in the method of claim 1. The Examiner finds:

> Tsuda teaches determination of the orientation of the device includes determination of a geographic orientation of the device (column 5, lines 51-54, see "*the distance and azimuth angle of the binocular 200 relative to the binocular 100*", column 6, lines 50-54, see "*azimuth angle*" and "*in the direction from North, East, South, West*". In addition, column 8, lines 44-45, see "*in the field of view of each binocular* (*or* in the direction of the other user), *the user can read out those information with viewing the other user*". In order for one binocular in view (or *in the field of view*) of another binocular, another binocular need to adjust its orientation and Tsuda's "*in the field of view of each binocular*" reads on Applicant's "*accordance with that orientation*").

(Ans. 6-7).

We generally concur with the Examiner's findings which we summarize as follows. Tsuda's user determines the orientation of his binocular device by locating, in the field of view of his binocular, the other

user's binocular, while also viewing a display of latitude, longitude, and altitude information pinpointing both binocular positions, and also viewing a display of the relative positions of the two binoculars in terms of distance, altitude difference, and azimuth angle. When such viewing and display occurs, the user has determined that his binocular is orientated toward the visually displayed specific latitude, longitude, and altitude information of the other binocular. (*See* Tsuda, abstract; col. 7, ll. 10-55; Figs. 3-4). Alternatively, the user also determines the device orientation "by directing the binocular . . . referring to a compass." (Tsuda, col. 7, ll. 54-55).

Therefore, Appellants' conclusory statement does not demonstrate error in the Examiner's position that Tsuda teaches "determining an orientation of the device" as called for in claim 1.

The second portion of Appellants' statement quoted above, asserting that Tsuda does not teach "providing information in accordance with that orientation" (Br. 5), is not commensurate in scope with the claim, generally as the Examiner indicated: "the features upon which applicant relies (i.e., 'provide information in accordance with that orientation' of the mobile communication device) are not recited in the rejected claim(s)." (Ans. 16-17) (Emphasis omitted).[1] Accordingly, Appellants' statement fails to convince us of error in the Examiner's position.

[1] The Examiner also addressed the argument in the passage (Ans. 6-7) quoted above.

However, while not required to support our determination, to clarify the record, we note that there are two steps set forth in the claim to which Appellants' statement may apply:

> supplying visual information to a user *appropriate to the location and orientation* of the device from a collection of information stored on the information network, various elements of the collection of information *being associated with specific location*s;
>
> . . .
>
> and automatically retrieving and displaying new visual information to the user *as the location and orientation of the device change* so that new elements of the collection of information *associated with locations* in proximity to the location of the device are supplied to the user as the location and orientation of the device change.

We address each of the two steps below.

As to the "supplying" step, Tsuda's displayed longitude, latitude, and altitude information in the user's binocular, related to the positions of the first and second binoculars and relative locations thereof, as supplied from GPS satellites (col, 8, ll. 1-13), constitute supplying visual information from an information network appropriate to the location and orientation of the first device; i.e., the visual location information is "appropriate" to any orientation because the user can determine the location of the first or second binocular device (using Tsuda's disclosed compass if required). Thus, we generally concur with the Examiner's finding that "Tsuda's '*telescopes*' can move around *and* communicate with each other[)], supplying visual information to a user appropriate to the orientation of the device . . . ." (Ans. 5, citations to Tsuda omitted).

As to the "automatically retrieving and displaying" step, the limitation requires that *both the location and orientation of the device change* as a condition precedent to automatically retrieving and displaying new *location* information. Tsuda's system meets this claim step also. There is no dispute that Tsuda's system automatically supplies new location information when the device location changes; therefore, it follows that the system also necessarily supplies such information when both location and orientation change. The verb "change," requiring plural subjects, supports our reading of the claim that both location and orientation must change as a condition precedent to displaying new location information.

We also note that while the claim requires determining orientation; the limitation calling for automatically displaying new information as both the location and orientation change does not require the visual information to change as a *function* of either a new orientation or the previously determined orientation. Rather, the claim requires "new elements of the collection of information associated with *locations*" *as* (i.e., when) the orientation and location change (emphasis added). Thus, Appellants' statement that Tsuda's "information does not depend on the orientation of either optical instrument" (Br. 5), while correct, is not relevant to any particularly argued claim limitation. [2] Accordingly, Appellants have failed to convince us of error in the Examiner's position.

[2] Appellants' related statement that Tsuda does not disclose Appellants' "point and push facility" (Br. 5) also fails to address any claim limitation, so that the argument is not commensurate in scope with the claim. (*Compare*
Footnote continued on the next page.

Appellants also assert that Chern does not disclose "determining a location and orientation of a device and automatically retrieving and displaying new visual information to a user as the location and orientation of the device changes." (Br. 4). As indicated above, Tsuda teaches the above limitations. The Examiner applied Chern to teach

> determining a location of the device (column 6, lines 21-23, see "*based on the handset location*"), and supplying visual information (column 5, lines 53-58, see "*The information maybe displayed on the handset*" and column 3, lines 59-60, see "*a display for displaying relevant information*") to a user appropriate to the location of the device from a collection of information stored on the information network (see column 6, lines 44-47), various elements of the collection of information being associates with specific location (see column 6, lines 21-23, see "*based on handset location*" and column 5, lines 56-58).

(Ans. 4).

We generally concur with the Examiner's findings regarding Chern and find them to be cumulative to Tsuda's teachings. Appellants' statement that Chern does not "monitor the location of a device so as to provide new information elements associated with locations in proximity to the location of the device, as in the claims of the present invention" (Br. 4-5), lacks factual support and also contradicts Appellants' other statements which support the Examiner's position:

Ans. 17 – stating that "limitations from the specification are not read into the claims.")

> Chern teaches that the device may respond to user queries about points of interest within a distance from the device, to provide driving directions or to provide traffic alert information or route recalculation in response to traffic conditions along a route to a user's destination, with information relating to a user's location being taken into account in triggering alerts or route recalculation. In addition, Chern teaches attachment of advertisements to alert messages transmitted to a user. The content of the advertisements may take a user's location into account.

(Br. 4).

We concur with this statement and find that Chern also teaches displaying updated map, location, and points of interest information as the user's device location changes, with such information automatically displayed as new visual information associated with locations in proximity to the location of the device (*see e.*g. Chern; col. 9, ll. 3-24; col. 9, ll. 59-64; col. 10, ll. 10-17; col. 11, ll. 5-20). Thus, we determine that Chern teaches all the claim steps except for explicitly determining orientation. However, we also note that Chern, at a minimum, suggests determining orientation, because Chern's driving direction system requests position and speed updates to determine if a user missed a waypoint on a computed and displayed map route, and if so, "a user may be directed to backtrack to the passed waypoint" (col. 8, ll. 13-15). In this situation, as "backtrack" implies turning around or ceasing the current direction of travel, the system has determined that the user's orientation is roughly 180 degrees away from the way point. In any case, the combination of Chern's driving direction system, rendering specific and updated directional information related to a map, and Tsuda's compass amounts to the combination of familiar elements

according to their established functions, thereby yielding the predictable result of automatically retrieving and displaying new visual information to the user as the location and orientation of the device change, as set forth in the claim.

Appellants also assert: "However, neither Chern nor Yurkovic teaches or makes obvious determining an orientation of a device and displaying information appropriate to a location and orientation of a device." (Br. 5). We have determined above that Tsuda and/or Chern teach the limitation.

Accordingly, as Appellants have failed to demonstrate error in the Examiner's findings, we sustain the rejection of claim 1 and claims 2, 5, 7-9, 11-13, 15-28, 31, and 33-42 not separately argued.

As to the rejections of claims 3, 4, 6, 10, 29, 30, and 32, Appellants provide no arguments directed to the additional references of Kikinis for claims 3, 4, 10, 29, and 30, and Kikinis and Hashimoto for claims 6 and 32, but instead assert that "each of the claims 1-13 and 14-42 . . . patentably defines over the cited art (Chern and Yurkovic) and over a combination of Tsuda with the cited art and, therefore, should be allowable." (Br. 5-6). Since we have found no error in the rejection based upon the combination of Chern, Yurkovic and Tsuda, we will sustain the rejections of claims 3, 4, 6, 10, 29, 30, and 32 for the same reasons as indicated *supra* regarding claim 1.

CONCLUSION

For the reasons outlined above, we will sustain the rejections of claims 1-13 and 15-42.

DECISION

The decision of the Examiner is *affirmed*.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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